

P21224.A04



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masami SHIRAI et al.

Group Art Unit: 2872

Appln. No. : 09/978,542

Examiner: T. NGUYEN

Filed : October 18, 2001

For : A SURVEYING INSTRUMENT

Handwritten: elect 10/14/03

RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Examiner's restriction requirement dated September 12, 2003, setting a one month period for response extending until October 14, 2003, (October 12, 2003 being a Sunday and October 13, 2003 being a holiday), Applicants elect, with traverse, the invention identified by the Examiner as Group I. Claims 1-11, 18, 19, 24, 27 and 28 are considered to be "readable" on the invention of Group I (as set forth by the Examiner).

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Applicants respectfully traverse the Examiner's restriction requirement.

The Examiner has characterized the relationship between the inventions of Groups I (claims 1-11, 18, 19, 24, 27 and 28) and II (claims 12-17, 20-23, 25, 26 and 29) as that of "subcombinations disclosed as usable together in a single combination".

However, Applicants note that each of claims 1 and 12 recite, inter alia, "A surveying instrument comprising: a sighting telescope having an objective lens and an eyepiece;"

Accordingly, each group of claims identified by the Examiner is directed to a surveying instrument having a sighting telescope with an objective lens and an eyepiece. Applicants submit that such groups of claims can not be characterized as directed to subcombinations usable together in a single combination, since both groups of claims are directed to the combination (i.e., a surveying instrument). In other words, although each group of claims includes recitation of a different "light shield device", the claims are directed to entire surveying instruments, rather than the light shield devices alone.

Additionally, even if the Examiner's characterization of Groups I and II as defining properly restrictable subcombinations were to be considered correct, Applicants respectfully request that all of the inventions defined in claims 1-29, nevertheless, be examined in the instant application, pursuant to the guidelines set forth in M.P.E.P. §803. That is, the Examiner is respectfully requested to reconsider the restriction requirement and find that there would not appear to be a "serious burden" on the Patent and Trademark Office in examining claims directed to the non-elected invention since the Examiner will have to search for a surveying instrument having a light shield device similar to that of claims 12-17, 20-23, 25, 26 and 29, while searching for the surveying instrument having a light shield device of claims 1-11, 18, 19, 24, 27 and 28.


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It would appear that the search for the inventions identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the invention of Group I, there would not appear to be a serious burden in continuing the examination of the other invention of Group II. For this reason, and consistent with office policy as set forth in M.P.E.P. 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

For the foregoing reasons, it is submitted that the restriction requirement in this application is improper and it is respectfully requested that it be reconsidered and withdrawn.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Masami SHIRAI et al.

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In re application of Masami SHIRAI et al.

Serial No. : 09/978,542

Filed : October 18, 2001

For : A SURVEYING INSTRUMENT

Attorney Docket No. P21224

Mail Stop Non-fee

Group Art Unit: 287

Examiner: T. NGUYEN

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COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is a Response to Restriction Requirement with traverse in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 29	29	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 2	3	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☒ A Check in the amount of \$_____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Bruce H. Bernstein
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